



LE REGISTRAIRE DES MARQUES DE COMMERCE  
THE REGISTRAR OF TRADE-MARKS

**Citation: 2019 TMOB 4**

**Date of Decision: 2019-01-15**

**IN THE MATTER OF A SECTION 45 PROCEEDING**

**Gowling WLG (Canada) LLP**

**Requesting Party**

**and**

**MiMi Food Products Inc.**

**Registered Owner**

**TMA658,255 for GOURMET PIZZA  
EXPRESS**

**Registration**

[1] This is a decision involving a summary expungement proceeding with respect to registration No. TMA658,255 for the trade-mark GOURMET PIZZA EXPRESS (the Mark), owned by MiMi Food Products Inc.

[2] The Mark is currently registered in association with the following goods and services:

Goods: Pizza

Services: Restaurant services

[3] For the reasons that follow, I conclude that the registration ought to be expunged.

## THE PROCEEDING

[4] On November 25, 2016, the Registrar of Trade-marks sent a notice under section 45 of the *Trade-marks Act*, RSC 1985, c T-13 (the Act) to MiMi Food Products Inc. (the Owner). The notice was sent at the request of Gowling WLG (Canada) LLP (the Requesting Party).

[5] The notice required the Owner to furnish evidence showing that it had used the Mark in Canada, at any time between November 25, 2013 and November 25, 2016, in association with each of the goods and services specified in the registration. If the Mark had not been so used, the Owner was required to furnish evidence providing the date when the Mark was last in use and the reasons for the absence of use since that date.

[6] The relevant definitions of use are set out in sections 4(1) and 4(2) of the Act as follows:

4(1) A trade-mark is deemed to be used in association with goods if, at the time of the transfer of the property in or possession of the goods, in the normal course of trade, it is marked on the goods themselves or on the packages in which they are distributed or it is in any other manner so associated with the goods that notice of the association is then given to the person to whom the property or possession is transferred.

(2) A trade-mark is deemed to be used in association with services if it is used or displayed in the performance or advertising of those services.

[7] It is well established that the purpose and scope of section 45 of the Act is to provide a simple, summary, and expeditious procedure for removing “deadwood” from the register and, as such, the evidentiary threshold that the registered owner must meet is quite low [*Uvex Toko Canada Ltd v Performance Apparel Corp*, 2004 FC 448, 31 CPR (4th) 270].

[8] In response to the Registrar’s notice, the Owner furnished the affidavit of Mike Primucci, the President of the Owner, sworn February 16, 2017, together with Exhibits A, B, and C.

[9] Both parties filed written submissions; however, only the Requesting Party requested and attended an oral hearing in the matter.

## THE EVIDENCE

[10] Mr. Primucci attests that the Owner (and/or its predecessor-in-title) has continuously used the Mark in Canada in association with “pizza” during the relevant period, with the Mark appearing on the packaging for the goods.

[11] Mr. Primucci explains that the Owner develops products for pizza parlours, grocery stores, and restaurateurs, developing products specific to meet their needs. He states that as a result, there is no specific way that the Mark accompanies the goods, but is dependent upon the needs of the Owner’s customers.

[12] As an example of use, Mr. Primucci attests that during the relevant period, the Owner sold pizza products bearing the Mark to Pino’s grocery store located in Sault St. Marie, Ontario. He attaches as Exhibit B, representative print-outs of invoices to Pino’s, which he states shows sales of pizza products during the relevant period.

[13] Mr. Primucci explains that due to the specific needs of Pino’s, the pizza dough and packaging are shipped separately, with the pizza dough placed into bags which bear the Mark by Pino’s employees. He attests that the pizza product is then sold to Canadian consumers bearing the Mark, wherein the Mark appears on the bags and is visible to consumers when purchased in stores. In support, he attaches as Exhibit C, pictures of the bags, as well as representative pictures of how the goods appeared to consumers in Pino’s stores during the relevant period. The packaging for the product describes that product as “pizza dough balls - perfect for pizza, panzerotti, & focaccia”.

[14] Mr. Primucci concludes his affidavit by stating that he concedes that the Owner has not used the Mark in association with the services during the relevant period.

## ANALYSIS AND REASONS FOR DECISION

[15] To begin with, as the Owner has conceded that it has not used the Mark in association with the services during the relevant period, and no special circumstances have been brought forth to excuse the absence of use, at the very least, the services will be deleted from the registration.

[16] With respect to the goods, the Requesting Party submits that Mr. Primucci describes use of the Mark by the Owner with respect to “pizza products”, but does not provide a specific description of what these products are and does not provide even as much as a bare assertion that the Mark has been used in association with “pizza” during the relevant period. Further to this, the Requesting Party notes that the invoices in Exhibit B do not identify the Mark and are for “pizza dough balls”, “par-baked crusts”, and “dough ball bags”, all of which are not “pizza”. Lastly and similarly, the Requesting Party submits, the packaging in Exhibit C is with respect to “pizza dough balls”, and not “pizza”.

[17] The Owner, on the other hand, submits that it is quite clear that the goods were marketed as pizzas, that pizza dough or par-baked crust are essential elements of any pizza, and that “pizza products” sold by the Owner fall within the meaning of “pizza” as normally understood by consumers. Further to this, the Owner submits that section 45 proceedings are not the place for a meticulous analysis of the goods, and when two parties disagree as to what constitutes the goods, the registration should be maintained [citing *Smart & Biggar v Diversey, Inc*, 2012 TMOB 3, and; *ExxonMobil Oil Corp v Mövenpick-Holding AG*, 2013 TMOB 97 regarding interpretation of goods]. Lastly, the Owner submits that the Goods and Services Manual maintained by CIPO does not list “pizza dough” or “par-baked crusts” as acceptable descriptions of goods; however, the term “pizza” or “pizzas” are both acceptable. The Owner submits that given that there is no entry for “pizza dough” alone, the term “pizza” must encompass different elements of a pizza including pizza dough.

[18] However, I agree with the Requesting Party that a meticulous analysis of the goods in the present case is not required to arrive at the conclusion that “pizza dough” and “par-baked crusts” are not “pizza”; but rather are components of “pizza” itself. The fact that one can readily discern that these are different, albeit related goods, distinguishes the present case from *Diversey, supra*, and *ExxonMobil, supra*. Furthermore, that there is no entry for “pizza dough” alone in the Goods and Services Manual, is not determinative. The Goods and Services Manual is not intended to be exhaustive, and simply because a specific term or expression for constituent parts of “pizza” may be not found in the Manual, does not make “pizza dough” and “par-baked crusts” the equivalent of “pizza”. Indeed, contrary to the Owner’s submission that the product is marketed as “pizza”,

the packaging for the goods clearly indicates the goods to be “pizza dough balls – perfect for pizza, panzerotti & focaccia”.

[19] Having regard to the aforementioned, the Owner has failed to provide a *prima facie* case of use in association with the registered goods [*Uvex Toko, supra*, and; *John Labatt Ltd v Rainier Brewing Co et al* (1984), 80 CPR (2d) 228 (FCA)].

DISPOSITION

[20] Accordingly, pursuant to the authority delegated to me under section 63(3) of the Act, the registration will be expunged in compliance with the provisions of section 45 of the Act.

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Kathryn Barnett  
Hearing Officer  
Trade-marks Opposition Board  
Canadian Intellectual Property Office

**TRADE-MARKS OPPOSITION BOARD  
CANADIAN INTELLECTUAL PROPERTY OFFICE  
APPEARANCES AND AGENTS OF RECORD**

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**HEARING DATE** 2018-09-13

**APPEARANCES**

No one appearing

FOR THE REGISTERED OWNER

Monique M. Couture

FOR THE REQUESTING PARTY

**AGENTS OF RECORD**

Wilson Lue LLP

FOR THE REGISTERED OWNER

Gowlings WLG (Canada) LLP

FOR THE REQUESTING PARTY